

ELECTION WITH TRAVERSE

Pursuant to 35 U.S.C. § 121, the Office Communication mailed December 16, 2005 requires the Applicant to elect a single disclosed species for prosecution on the merits, to which the claims shall be restricted if no generic claim is finally held to be allowable. The communication of December 16, 2005 further states that currently, claim 1 is considered to be generic by the Examiner.

In accordance with the provisions of 35 U.S.C. § 121, Applicant hereby elects with traverse **Species V – FIG. 9**, as defined by the Examiner in the referenced communication. Further in accordance with the provisions of § 121, Applicant hereby asserts that claims 1, 3, 5-6, 9, 11-14, 17, 19-20, and 30-34 would all read upon the elected **Species V – FIG. 9**, in the event that no generic claim is finally held to be allowable.

REMARKS

The Restriction Requirement is respectfully traversed for the reasons set forth in the following paragraphs:

1. The Restriction Requirement is improper, because the Examiner has failed to provide reasons and/or examples to support his conclusions, in accordance with MPEP § 803. (Examiners must provide reasons and/or examples to support conclusions...).

2. The Restriction Requirement is also improper, because examination of all claims on the merits imposes no additional burden on the Examiner, even if the Examiner is correct in his assertion that the claims include claims to independent and distinct inventions. In paragraph 2 of the Restriction Requirement, the Examiner affirmatively states that "[c]urrently, claim 1 is generic." Given the Examiner's position, that claim 1 is generic, the Examiner is required to examine all claims in the application, regardless of any election of species made by the Applicant, in accordance with the definitions of Species I, through VIII as defined by the Examiner in paragraph 1 of the Restriction Requirement.

3. It cannot be shown by the Examiner that a search and examination of the entire Application causes a serious burden as required by Section 803 of the MPEP. Accordingly,

the Examiner must proceed with examination of all claims, even if they are directed to independent or distinct inventions.

CRITERIA FOR RESTRICTION BETWEEN PATENTABLY DISTINCT INVENTIONS

There are two criteria for a proper requirement for restriction between patentably distinct inventions:

- (A) The inventions must be independent (see MPEP § 802.01, § 806.04, § 808.01) or distinct as claimed (see MPEP § 806.05 - § 806.05(i)); and
- (B) **There must be a serious burden on the examiner if restriction is required (see MPEP § 803.02, § 806.04(a) - § 806.04(i), § 808.01(a), and § 808.02).**

MPEP § 803 at page 800-4 (Emphasis added).

Contrary to the requirements for a proper Restriction Requirement, maintaining the Restriction Requirement in the present Application places a “serious burden” on the operation of the Patent Office, the public and the applicants. Filing additional Applications directed to the non-elected inventions unnecessarily burdens the Patent Office because it must assume the additional and unnecessary labor involved in examining separate Applications. The public is burdened because it has to locate and review at least two patents (due to the further restriction of an individual species), instead of one, in order to fully ascertain the scope of the patent protection provided the subject matter in the specification. Finally, the applicant is burdened because she must bear the expense of filing and prosecuting multiple applications. This last consideration is particularly severe in this Application, because the inventor has a limited budget for prosecution of her patent Application.

In contrast to the burdens imposed by the Restriction Requirement, to the ongoing operation of the Patent Office, the public and the applicants, the burden of examining all of the claims currently pending in the Application, instead of just one group of the claims, is negligible. In this regard, any additional searches that the Examiner must conduct for claims readable on the non-elected Species are likely to overlap. In fact, a complete search of the claims readable on the elected Species is likely to include all, or at least most, of the field of search for the claims readable on the non-elected Species, given that, as correctly stated by

In re Appln. Of: Horst et al.
Application No.: 10/803,308

the Examiner in his Restriction Requirement, claim 1 is generic. Therefore, any additional search that may be required for claims directed to non-elected Species, for which claim 1 is generic should not create a serious burden for the Examiner.

CONCLUSION

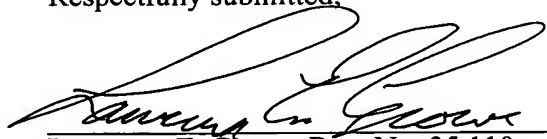
For the reasons stated above, it is respectfully submitted by the Applicant that the present patent application should not be subject to a Restriction Requirement.

The Restriction Requirement should be withdrawn, and all of the claims should be examined on the merits, particularly since the Examiner is required to do so under the applicable patent statutes, rules and regulations, given that the Examiner has found that claim 1 is generic to all species alleged by the Examiner.

In any event, the Applicant has provisionally elected, with traverse, the single Species V – FIG. 9, as defined by the Examiner in the Restriction Requirement, and has indicated that claims 1, 3, 5-6, 9, 11-14, 17, 19-20, and 30-34 are readable upon the elected species, in the event that no generic claim is finally held to be allowable.

If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the present patent application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,



Lawrence E. Crowe, Reg. No. 35,110
Reinhart Boerner Van Deuren P.C.
483 N. Mulford Road, Suite 7
Rockford, Illinois 61107
(815) 484-1900 (telephone)
(815) 484-1032 (facsimile)

Date: January 11, 2006